



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,325	06/02/2000	Guy Nathan	871-83	7170

7590

09/24/2002

Joseph S Presta
Nixon & Vanderhye PC
1100 North Glebe Road
8th Floor
Arlington, VA 22201-4714

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,325

Applicant(s)

NATHAN ET AL.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 & 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3625

DETAILED ACTION

Specification

Content of Specification

1. With regards to independent claims 1, 9, and 14 the elements and steps are not separated by a line indentation. For example, in claim 1, see steps of displaying an event and selection of event are not separated by a line indentation, in claim 9, means element for displaying information is not separated by a line indentation from the preamble of the claim, and in claim 14, elements of host server, second network, means of scanning file are not separated by a line indentation. See Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
2. Claims 2-7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. With regards to claim 2, it is dependent on claim 1 but its limitation of choosing or saving a message fails to further limit the subject matter of claim 1. In claim 1 there is no reference of special message. Claims 3 and 4 are dependencies of claim 2 and therefore inherit

the deficiency of claim 2. Similarly, dependent claim 5 fails to further limit the subject matter of claim 1. In claim 1 there is no reference of jukeboxes, server site and connection to Internet.

Claims 6-8 also have similar deficiencies.

3. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material of French patent application 98 09358 and PCT WO 96/12258 incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Drawings

4. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. Fig.1 of the instant application is exactly same as Fig.1 of US Patent 6,308,204, for which PCT Publication date is April 25, 1996. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: File 841 on pages 11, 13, and 15, and module 551 on page 11. A proposed drawing correction or corrected

Art Unit: 3625

drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 51,52, and 55 in FIG.1, 89, 90,91,92, 92a, 93,94,95,96,97,98, 701, 712, and 856 in FIG.2, 5,6,61,53,34, and 851 in FIG.3, and 8529 in FIG.4. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "840" has been used to designate both " Disk Jockey Requested Songs List " and " Disk Jockey Special Requested List " in FIG.3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claims 1-9 are objected to because of the following informalities: In claim 1, "the event" in line 4, page 17 to be replaced by "an event", "the advance order" in lines 5-6, page 17 to be replaced by "an advance order", " the identity of destination equipment" in lines 9-10, page 17 to be replaced by " an identity of destination equipment ", "the date and time" in line 11, page 17 to be replaced by "date and time". In claim 6, " the terminal" in lines 3-4, page 18, to be replaced by " a terminal ", " the server" in line 8, page 18 to be replaced by " a server". In claim 7, "the

Art Unit: 3625

host server" in lines 15-16, page 18 to be replaced by " a host server". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The steps in process claims and structure in the device claims must be organized and correlated in such a manner to present a complete operative process and device.

Overview

10. As analyzed above the claimed invention is not clear. At best, the examiner has understood the claimed invention as follows:

A user can access a host server through an user terminal on Internet, can select a list of songs suitable for a particular event, execute an advance order to play those songs at a later date on a scheduled time and date and selected destination. The selected songs are transmitted and downloaded on jukeboxes from a host server, via Internet. The invention also

teaches accepting and storing messages and accepting payment. In conformity with this understanding examiner has searched and retrieved prior art.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nathan (US Patent 6,336,219) and further in view of Kleiman (US Patent 5,959,945).

Nathan teaches the claimed limitations of claims 1-14, that is a method, device and system where a jukebox and a server can communicate with each other and receive messages and store them, display the identity of the destination equipment, receive the selection to be played on the destination equipment, special requests are recorded and downloaded on a file, execution of the request at a given time and date, making payments, (at least see, abstract, FIG.1. Note: Fig.1 which represents the electrical scheme of Patent '219 is similar to that displayed in the Fig.1 of the claimed invention, abstract, col.1, lines 15-38, col.1, line 66-col.2, line 24, col.4, lines 63-67, col.8, line 9-col.10, line 22. Note: Nathan's teaching of "enable a particular song to be played at a defined time", relates to play the selected/requested in advance songs at a later date at the destination equipment.

Nathan does not show ordering in advance selected songs for an event. Kleiman, in the same field of distributing music to a plurality of Jukeboxes, teaches ordering in advance

Art Unit: 3625

selected songs for an event (at least see, col.4, lines 21-59, "...A music hierarchy system exists in the juke box for determining customer preferences... It is further object of the present invention to provide... with music on demand and music based on local user needs at deferred times ...". Note: customer preferences and music on demand based on local user needs at deferred times in Kleiman relate to customer's selection and ordering in advance for a desired event as claimed in the application. Also see col.5, line 60-col.8, line 67). It would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Nathan to include the concept of ordering in advance selected songs for an event, as shown in Kleiman. Doing so would help the users to enable a particular selection of songs to be played at a defined time, as suggested in both Nathan (col.8, lines 60-63) and Kleiman (col.4, lines 37-40).

Nathan/Kleiman does not teach displaying a list of events and selecting an event. Official Notice is taken of both the concepts and benefits of displaying a list of events and to selecting an event in the field of events related to social expressions like, bridal shower, baby shower, wedding, birthday, funerals, graduation, anniversary events enabling the user to select one of them and then making it convenient and easy to choose the item, like greeting card, gift, for that event. It would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Nathan/Kleiman to include the feature of displaying a list of events and selecting an event for playing a selection of songs. Doing so would make it convenient and easier for the user, as in the case of selecting greeting cards and gifts, to select the songs as per his preference and required by the occasion.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Press release, " MusicMatch Announces Commercial Availability of Meta Trust Certified MusicMatch Jukebox ", PR Newswire; New York; Nov 15, 1999, extracted from Internet, <http://proquest.umi.com> on 09/17/2002 discloses the " MusicMatch Jukebox TM software application enabling content providers to sell, and music fans to purchase music over the Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
September 18, 2002


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600